



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Hiroyuki OSADA et al.

Group Art Unit : 1642

Appl. No. : 10/627,616

Examiner : Misook YU

Filed : July 28, 2003

For : MUTANT PLK PROTEIN AND GENE ENCODING THE SAME

**ELECTION WITH TRAVERSE**

Commissioner for Patents  
U.S. Patent and Trademark Office  
Customer Service Window, Mail Stop Amendment  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22313

Sir:

This is in response to the requirement for restriction under 35 U.S.C. § 121 mailed from the U.S. Patent and Trademark Office on June 26, 2006, which sets a one month period for response until July 26, 2006. The one-month shortened statutory period for responding thereto is extended from July 26, 2006, to September 26, 2006, by a concurrently filed request for a two-month extension of time and payment of the appropriate extension of time fee.

Reconsideration and withdrawal of the Restriction Requirement are respectfully requested in view of the remarks which follow.

**REMARKS**

Claims 1-14 are pending in the application.

**Restriction Requirement**

The Office Action asserts that the application contains the following groups of inventions, which are allegedly distinct under 35 U.S.C. § 121. The

Action asserts that Applicants are required to elect a single invention to which the claims will be restricted.

I. Claims 1-11, allegedly drawn to a method of detecting Plk mutant protein using an antibody, classified in class 435, subclass 501.

II. Claims 12-14, allegedly drawn to a method of detecting Plk mutant nucleic acid using primers, classified in class 435, subclass 6.

The Office Action further requires that Applicants elect a species claim from S487G, P509S, N496S, and R512W.

### **Election**

In order to be responsive to the requirement for restriction, Applicants elect the invention set forth in Group II, i.e., claims 12-14, *with traverse*. Applicants further elect species R512W, *with traverse*. At least claims 8-14 are readable on the elected species.

### **Traverse**

Notwithstanding the election of Group II and species R512W, in order to be responsive to the Restriction Requirement, Applicants respectfully traverse the Examiner's requirement for restriction.

Although the Examiner argues that the claims in Group I and II are distinct, Applicants respectfully submit that a restriction is inappropriate in this case because there should be no undue search burden to examine the claims in Groups I and II. Under MPEP § 803, "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it

on the merits, even though it includes claims to distinct or independent inventions.”

Applicants note that the claims in Group II are allegedly drawn to a method of detecting Plk mutant nucleic acid, while the claims of Group I are allegedly drawn to a method of detecting Plk mutant protein encoded by said Plk mutant nucleic acid. Accordingly, as a practical matter, the searches for inventions I and II should significantly overlap because the claims in Group I and II both relate to the same Plk mutant nucleic acid sequence. Thus, there should not be an undue search burden.

Furthermore, Applicants respectfully note that there may have been an oversight in including claims 8 through 11 with the claims in Group I. Group I is allegedly drawn to a method of detecting Plk mutant protein by using an antibody. Yet, claims 8 through 10 recite a method of cell analysis detecting the presence of a mutant Plk nucleotide sequence, and claim 11 recites a method of diagnosing a malignant tumor which comprises detecting the presence of a mutant Plk nucleotide sequence. The claims in Group II are allegedly drawn to a method of detecting a Plk mutant nucleic acid, and claims 8 through 11 recite this same element (i.e. detecting a mutant Plk nucleotide sequence). Accordingly, Applicants respectfully submit that claims 8 through 11 should be considered with Group II.

With regard to the election of species argument, Applicants also respectfully submit that there should be no undue search burden in examining all species together. Applicants request that all of the pending claims and all


species be considered together and that the restriction be withdrawn. In view of the foregoing, it is respectfully requested that the Examiner reconsider the requirement for restriction, and consider the claims of elected Group II with the claims of Group I.

### CONCLUSION

For the reasons discussed above, it is respectfully requested that the Examiner's requirement for restriction be withdrawn. Withdrawal of the requirement for the restriction with the examination of all claims pending in this application is respectfully requested. Favorable consideration with early allowance of the pending claims is most earnestly requested.

If the Examiner has any questions, or wishes to discuss this matter, please call the undersigned at the telephone number indicated below.

Respectfully Submitted,  
Hiroyuki OSADA et al.

  
Bruce H. Bernstein  
Reg. No. 29,027 42,920

September 26, 2006  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191